

## REMARKS

### I. Introduction

Claims **1-22** are currently pending in the present application. Claims **1**, **2**, and **17** are independent. The status of the pending claims is as follows:

- (A) the Examiner states that claims **17-22** are directed to **allowable** subject matter;
- (B) claims **1-16** stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 6,820,260 (hereinafter “Flockhart”); and
- (C) claim **1** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent No. 6,614,783 (hereinafter “Sonesh”) in view of Flockhart.

The Examiner further alleges that prior-filed U.S. Patent Application Serial No. 09/657,338 (now U.S. Patent No. 6,301,354) fails to provide adequate support or enablement for one or more claims of the present application, allegedly rendering Applicants’ claim of priority to U.S. Patent Application Serial No. 09/657,338 invalid.

Upon entry of this amendment, which is respectfully requested, claim **2** will be amended to more distinctly point out one embodiments and new claim **23** will be added. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### II. Claim of Priority

Applicants respectfully note that at least one claim of the present application is fully supported pursuant to 35 U.S.C. §112 by U.S. Patent Application Serial No. 09/657,338 (now U.S. Patent No. 6,301,354). New claim **23**, as one example, finds full support and enablement in the specification of U.S. Patent Application Serial No. 09/657,338. Applicants therefore respectfully request that the Examiner recognize the validity of the claim of priority to U.S. Patent Application Serial No. 09/657,338.

### III. The Examiner's Rejections

#### A. 35 U.S.C. §102(b)

Claims **1-16** stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Flockhart. Applicants respectfully traverse this ground for rejection as follows.

##### **1. The reference fails to teach or suggest: *determining a second merchant* (claim 1)**

Applicants respectfully assert that Flockhart fails to teach or suggest limitations of claim **1**. For example, Flockhart fails to teach or suggest *determining a second merchant*.

Flockhart describes a system that allows customized applets to be downloaded to callers waiting in call queues. While Flockhart does describe one version of an applet being an “order form” (presumably associated with a first merchant), nowhere does Flockhart teach or suggest *determining a second merchant*. It seems apparent upon reading Flockhart, for example, that Flockhart only contemplates a call center. It also seems apparent that the “order form” is associated with the call center/first merchant, as Flockhart describes a call center operator being able to assist in finalizing the filing out of the order form (which presumably would not occur if the order form was for someone else’s products). Simply no other/additional merchant is contemplated by Flockhart.

Accordingly, at least because Flockhart fails to teach or suggest *determining a second merchant*, Flockhart fails to anticipate claim **1**. Applicants therefore respectfully request that this §102(b) rejection of claim **1** be withdrawn.

##### **2. The reference fails to teach or suggest: *establishing a connection, based on the access information, with the at least one merchant, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue* (claims **2-16**)**

Applicants respectfully assert that Flockhart fails to teach or suggest limitations of claims **2-16**. For example, Flockhart fails to teach or suggest *establishing a connection, based on the access information, with the at least one merchant, the connection enabling*

*the caller to make a purchase from the at least one merchant while the incoming call remains in the queue.*

Flockhart does not describe establishing a connection with a merchant. While Flockhart does describe allowing callers to fill out order forms while on hold, nowhere does Flockhart contemplate connecting the callers to a merchant associated with such order forms, much less establishing such a connection while the caller remains in the queue with the call center.

Accordingly, at least because Flockhart fails to teach or suggest *establishing a connection, based on the access information, with the at least one merchant, the connection enabling the caller to make a purchase from the at least one merchant while the incoming call remains in the queue,* Flockhart fails to anticipate claims **2-16**.

Applicants therefore respectfully request that these §102(b) rejections of claims **1-16** be withdrawn.

## B. 35 U.S.C. §103(a)

Claim **1** stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sonesh in view of Flockhart. Applicants respectfully traverse this ground for rejection as follows.

### **1. The reference fails to teach or suggest: determining a second merchant**

As described in Section A.1., Flockhart simply fails to teach or suggest *determining a second merchant*. Sonesh similarly fails to teach or suggest this limitation, as described in each of Applicants' Notice of Appeal with Request for Pre-Appeal Brief Review filed on September 7, 2005 and Applicants' Appeal Brief filed on November 18, 2005, the arguments of each of which is hereby incorporated by reference herein

Accordingly, at least because Sonesh and Flockhart fail to teach or suggest *determining a second merchant*, Sonesh and Flockhart, either alone or in combination, fail to render obvious claim **1**. Applicants therefore respectfully request that this §103(a) rejection of claim **1** be withdrawn.

## 2. No *Prima Facie* Case of Obviousness

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude Medical* 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. *In re Grabiak*, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The Examiner provides *no support* for the contention that it would have been obvious to modify Sonesh by selecting features from Flockhart. To ‘enhance user friendliness’, as asserted by the Examiner, is an unsupported conclusory statement that

falls far short of meeting the Examiner's burden of establishing a *prima facie* case for obviousness. Further, as described herein, Flockhart fails to teach or suggest embodiments associated with a **second merchant**, and therefore fails to make up for the deficiencies of Sonesh.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn.

#### IV. New Claim

New claim **23** is believed to be patentable over the cited references at least as described herein. Further, after reviewing the cited references, Applicants believe that none of the cited references, alone or in combination, teach, suggest, or render obvious at least:

- (i) *notifying, after the determination that the attendant is available, the caller that the attendant is available; or*
- (ii) *allowing the caller, after notifying the caller, to choose between (i) maintaining the connection with the selected entertainment option and (ii) establishing a connection with the attendant.*

Further, at least as claim **23** finds full support within U.S. Patent Application Serial No. 09/657,338, Flockhart is not an appropriate prior art reference.

**V. Conclusion**

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

**VI. Petition for Extension of Time to Respond**

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

May 25, 2006  
Date

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